IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: William K. Bodin, *et al.* | § | Group Art Unit: 2143 |
| Serial No.: 10/047,018 | § | Examiner: Lezak, Arrienne M. |
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| Title: Dynamic Current Device Status | § | Customer No. 34533 |
| | § | Confirmation No. 5704 |

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## APPEAL BRIEF

**Honorable Commissioner:**

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of March 21, 2006, and pursuant to the Notice of Appeal filed May 25, 2006.

## REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

## RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

## STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Twenty-one claims are filed in the original application in this case. Claims 1-21 are rejected in the Final Office Action. Claims 1-21 are on appeal.

## STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

## SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to the specification by page and line number and to the drawings by reference characters. There are three independent claims in the present case, claims 1, 8, and 15. Claim 1 is a method claim. Claims 8 and 15 claim respectively system and computer program product aspects of the method of claim 1.

Claim 1 of the present application claims:

1. A method of email administration comprising the steps of:

   **receiving** in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

**receiving** in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

**finding**, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

**sending** at least one of the email display capability status attributes to the sender.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph, for independent claim 8 is identified as follows. Note the precise correspondence with the elements of claims 1 and 15:

8. A system of email administration comprising:

**means for receiving** in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

**means for receiving** in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

**means for finding**, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

**means for sending** at least one of the email display capability status attributes to the sender.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph, for independent claim 15 are identified as follows. Note the precise correspondence with the elements of claims 1 and 8:

15. A computer program product of email administration comprising:

a recording medium;

**means**, recorded on the recording medium, **for receiving** in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

**means**, recorded on the recording medium, **for receiving** in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

**means**, recorded on the recording medium, **for finding**, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

**means**, recorded on the recording medium, **for sending** at least one of the email display capability status attributes to the sender.

The portion of the original specification that is most pertinent to claim 1 of the present application is pages 43-47 and Figure 17. The subject matter of claim 1 is concisely summarized as follows with a description beginning at line 1 of page 43 in the original application and with reference numbers in parenthesis referencing Figure17:

Turning now to Figure 17, an additional exemplary embodiment is shown as a method of email administration that includes receiving (1705) through a transcoding gateway (100), from a client device (1726), one or more email display status attributes describing one or more email display capability statuses for a domain. The email display status attributes typically are gathered into display capability status records (1730) of a kind illustrated in more detail in Figure 19.

...

Embodiments of the kind shown in Figure 17 typically include receiving (1704) in a transcoding gateway (100) from a sender (1402) an email display capability status request (1706) for a domain, in which the capability status request includes a domain identification (1409). As mentioned earlier in this specification, "domain" refers to a group of client devices administered together and identified by a common network address, typically an internet protocol address, that resolves to a domain name. Figure 19 illustrates a number of exemplary display capability status records (1730) for client devices in the domain 'grandma.net.' Although, the example capability status records in Figure 19 are for one domain only, in fact, a transcoding gateway in many embodiments serves more than one domain. The domain identification (1409 on Figure 17) in various embodiments is implemented, for example, as an internet address, internet protocol address, or as a domain name. In this specification, exemplary domain identifications, for convenience of reference, are generally taken as domain names.

The example embodiment of Figure 17 includes finding (1714), in dependence upon the domain identification (1409), at least one email display capability status record (1730) for the domain, wherein the email display capability status record for the domain includes display capability status attributes describing a status of an email display capability for the domain. Embodiments typically include sending (1720) at least one of the email display capability status attributes (1718) to the sender. This illustrates embodiments making direct use of domain names (1415) without using a sender identification to find capability records. Such embodiments typically return for sending (1720) back to the sender display capability status attributes for all the display capabilities for a domain. For a capability request for the domain 'grandma.net,' as shown in Figure 17, such an embodiment returns attributes for the ten display capability status records (1950) through (1968). Although it is perfectly useful in the case of grandma's house to send all the capability status records, in many embodiments, it is more useful to have additional limits on the number or capability records returned to the sender, especially in domains having many client devices having many display capabilities. Business, education, public, and Internet domains, for example, often have very large numbers of display devices and display capabilities.

Because claims 8 and 15 contain elements parallel to claim 1, the concise summary above of

claim 1 is applicable also to claims 8 and 15. The acts described in this concise summary above of the method of claim 1 are also the acts corresponding to each claimed function in the means plus functions claimed in claims 8 and 15 according to 35 U.S.C. § 112, sixth paragraph. The means for carrying out the acts described in claims 8 and 15 include automated computing machinery and recording media for machine-readable information concisely described at pages 11 – 12 in the original specification stating:

> The present invention is described primarily in terms of methods for administration of email and particularly in terms of methods for dynamically indicating client device status for client devices for displaying digital objects included in email. Persons skilled in the art, however, will recognize that any computer system that includes suitable programming means for operating in accordance with the disclosed methods also falls well within the scope of the present invention.
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> Suitable programming means include any means for directing a computer system to execute the steps of the method of the invention, including for example, systems comprised of processing units and arithmetic-logic circuits coupled to computer memory, which systems have the capability of storing in computer memory, which computer memory includes electronic circuits configured to store data and program instructions, programmed steps of the method of the invention for execution by a processing unit. The invention also may be embodied in a computer program product, such as a diskette or other recording medium, for use with any suitable data processing system.
>
> Embodiments of a computer program product may be implemented by use of any recording medium for machine-readable information, including magnetic media, optical media, or other suitable media. Persons skilled in the art will immediately recognize that any computer system having suitable programming means will be capable of executing the steps of the method of the invention as embodied in a program product. Persons skilled in the art will recognize immediately that, although most of the exemplary embodiments described in this specification are oriented to software installed and executing on computer hardware, nevertheless, alternative embodiments implemented as firmware or as hardware are well within the scope of the present invention.

## GROUNDS OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Applicants provide the following concise statement for each ground of rejection:

1. Claims 1, 4-8, 11-15, and 18-21 are rejected under 35 U.S.C § 103(a) as being anticipated by Shaffer, *et al.* (U.S. Patent No. 6,092,114).

2. Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C § 103(a) as being anticipated by Shaffer, *et al.* (U.S. Patent No. 6,092,114) in view of Schwalm, *et al.* (U.S. Patent No. 5,339,361).

## ARGUMENT

Applicants present the following arguments pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the two grounds of rejection in the present case.

### ARGUMENT REGARDING THE FIRST GROUND OF REJECTION: CLAIMS 1, 4-8, 11-15, AND 18-21 ARE UNPATENTABLE UNDER 35 U.S.C § 103(A) OVER SHAFFER

Claims 1, 4-8, 11-15, and 18-21 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, *et al.* (U.S. Patent No. 6,092,114). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification of Shaffer must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify Shaffer. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification of Shaffer. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the

modification of Shaffer does not establish a prima facie case of obviousness. The rejection of claims 1, 4-8, 11-15, and 18-21 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1, 4-8, 11-15, and 18-21.

The Proposed Modification Of Shaffer
Does Not Teach Or Suggest All Of The Claim
Limitations Of Applications Claims

To establish a prima facie case of obviousness, the proposed modification of Shaffer must teach or suggest all of the claim limitations of independent claims 1, 4-8, 11-15, and 18-21. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As Applicants will demonstrated below, Shaffer does not disclose each and every element of independent claim 1, and Shaffer therefore does not establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

Claim 1 of the present application claims:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

> sending at least one of the email display capability status attributes to the sender.

Shaffer Neither Teaches Nor Suggests Receiving In A Transcoding Gateway From A Client Device One Or More Email Display Status Attributes Describing One Or More Email Display Capability Statuses For A Domain

The first element of claim 1 claims "receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain...." Regarding the first element of claim 1, the Final Office Action at page 2 states:

> receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain, (Col. 2, lines 30-65 & Col. 6, lines 31-53);

That is, the Final Office Action takes the position that Shaffer at column 2, lines 30-65, and column 6, lines 31-53, teaches or suggests the first element of claim 1. Applicants respectfully note in response, however, that what Shaffer at column 2, lines 30-65, in fact discloses is:

> A method and system for exchanging electronic messages, such as email messages, include out-tasking conversions of file formats when it is determined that a client device does not include the resources to directly access an attachment without conversion. The access requirements of each attachment to electronic messages are compared to the capabilities of the client device to which the attachment is to be transferred. If it is determined that a file-format conversion is required, the conversion operation is assigned to a server that supports the process of reformatting the attachment. In an email environment, the server may be substantially equivalent to the conventional email server, but includes enhanced conversion capabilities.
>
> In one embodiment, the determination of whether an attachment is accessible without conversion by a target client device occurs at the server. One means of enabling the server to execute the determination is to maintain a universal register of applications at the server. The universal register may be a lookup table that identifies each application program stored at each client device supported by the server. The lookup table may also include data that matches each user (i.e., potential recipient) with a client device at which the user typically accesses messages (e.g., a target computer). When a message is received at the server, the file format of any attachment is identified. In its simplest form, this is accomplished by looking at the file extension (e.g., .BMP identifies a bitmap

> graphics format and MPEG indicates a specific video format). Alternatively, the format indicator may be embedded by the sending party within the message that includes the attachment. As a third possibility, the server may access each attachment in order to identify its file format. If a file-format conversion is necessary, the conversion can be implemented at the server, thereby freeing resources and processing time at the target client device. In this embodiment, the conversion may be transparent to the receiving party.

That is, Shaffer at column 2, lines 30-65, discloses an email server capable of file-format conversion based on the applications installed on a client device. The Final Office Action attempts to equate Shaffer's email server capable of file-format conversion with the transcoding gateway claimed in the present application. The transcoding gateway claimed in the present application, however, receives one or more email display status attributes that describe one or more email display capability statuses for a domain. For further explanation, Applicants describe the 'email display status attributes' in the original specification in the paragraph beginning at line 18 of page 43 stating:

> In addition to display capability attributes, the example display capability status records (1730) also have display capability status attributes including availability (1904) and recent usage (1906). The availability field (1904) is a status indication whether a display capability is currently available to receive email or to display digital objects included in email. Availability of a capability is affected by, for example, whether a client device or display device is powered off or on, or whether a client device or display device is online or offline. The recent usage field (1906) is a status indication of a recent time when a capability was used, that is, for example, a recent date and time when a client device received email or when a display device played or displayed a transcoded digital object or file.

That is, email display status attributes describe the *status* of an email display capability such as, for example, whether a display device is powered on or powered off. Shaffer's email server capable of file-format conversion does not receive one or more email display status attribute describing one or more email display capability statuses for a domain as claimed in the present application. The only thing that Shaffer's email server receives is an email with an attachment and the applications installed in the client device—neither of which teach receiving one or more email display status attributes as claimed in the present application because the email and the applications installed in the client device are not email display status attributes. Regarding the other limitations of the first element of claim 1, Shaffer at column 2, lines 30-65, does not even

mention 'email display capability statuses for a domain,' 'transcoding gateway,' 'receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain.' Shaffer's email server capable of file-format conversion based on the applications installed on a client device, therefore, does not teach or suggest receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain as claimed in the present application. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Shaffer at column 6, lines 31-53, Applicants respectfully note in response that what Shaffer at column 6, lines 31-53, in fact discloses is:

> At step 44, the access capabilities of the target client device 14, 16 and 18 are determined. Referring to FIG. 1, an application register 34 may be maintained at the server level. As is well known in the art, computers typically maintain an application register of programs stored at the computer. The application register 34 of FIG. 2 may be considered to be a universal application register that identifies all of the access capabilities of various client devices that are used to access email stored at the local server 12. In one embodiment, the application register is maintained as a lookup table. When a client device is first used to access email stored at the local server, the client device is polled to identify its access capabilities. The polling process may also be used to periodically update a lookup table that is compiled within memory of the server or within memory of an adjunct device. While the format converter 30 and the application register 34 are shown as being connected to the local server 12, the operations of the converter and register may be integrated into known servers. As an alternative to the polling approach, the client devices 14, 16 and 18 may be programmed to identify their individual access capabilities each time that a program is upgraded or added to the client device.

That is, Shaffer at column 6, lines 31-53, discloses receiving access capabilities from a target device in a server. The Final Office Action attempts to equate Shaffer's access capabilities with the email display status attributes claimed in the present application. As explained above, the email display status attributes as claimed in the present application describe email display capability *status* such as, for example, whether a display device is powered on or powered off.

Shaffer's access capabilities merely describe whether a client device has an application installed on the client device to open a particular type of file. Shaffer's access capabilities, however, have nothing whatsoever to do with email display status attributes claimed in the present application. Regarding the other limitations of the first element of claim 1, Shaffer at column 6, lines 31-53, does not even mention 'email display capability statuses for a domain,' 'transcoding gateway,' 'receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain.' Shaffer's receiving access capabilities from a target device in a server, therefore, does not teach or suggest receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain as claimed in the present application. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Shaffer Neither Teaches Nor Suggests Receiving In The Transcoding Gateway From A Sender An Email Display Capability Status Request For The Domain, Wherein The Capability Status Request Comprises A Domain Identification

The second element of claim 1 claims 'receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification....' Regarding the second element of claim 1, the Final Office Action at page 2 states:

> receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification, (Col. 6, lines 6-67 & Co. 7, lines 1-38)...

That is, the Final Office Action takes the position that Shaffer at column 6, lines 6-67, and column 7, lines 1-38, teaches or suggests the second element of claim 1. Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67, and column 7, lines 1-38, discloses in summary is receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment,

converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible. The Final Office Action attempts to equate Shaffer's email server that provides file-format conversion with the transcoding gateway as claimed in the present application. The transcoding gateway as claimed in the present application receives from a sender an email display capability status request for the domain. In contrast to the transcoding gateway of the present application, the only thing Shaffer's email server receives from a sender is an email with an attachment. Shaffer's email server never once receives an email display capability status request. Shaffer's failure to teach an email display capability status request, however, is understandable because Shaffer does not teach or suggest email display capability status as explained above. Furthermore, the email display capability status request as claimed in the present application is a status request for a domain. In contrast, Shaffer is clearly oriented to a single target/client device and not to the display capability status request for an entire domain as claimed in the present application. Regarding the other limitations of the second element of claim 1, Shaffer at column 6, lines 6-67, and column 7, lines 1-38, does not even mention 'wherein the capability status request comprises a domain identification,' 'email display capability status request for the domain,' or 'receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification.' Shaffer at column 6, lines 6-67, and column 7, lines 1-38, therefore, does not teach or suggest receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Despite the fact that Shaffer at column 6, lines 6-67, and column 7, lines 1-38, does not teach or suggest the second element of claim 1, the Final Office Action at pages 2 and 3 asserts that receiving in the transcoding gateway from a sender an email display capability status request for the domain as claimed in the present application is rendered obvious by Shaffer's email server that receives an email message stating:

> Examiner notes that Shaffer discloses a message sent by a sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status, especially in light of the fact that Shaffer discloses a capability status determination, a conversion means, and a notification to sender means, all related to the ability of the client/target device to receive the sender's message, and wherein the sender is notified of a client's inability to receive the message based on conversion requirements, which requirements are obviously an indication of the client/domain ability/capability to receive the sender's message.

That is, the Final Office Action sets forth a conclusory argument that the second element of claim 1 is disclosed because "said message would obviously be a default means of requesting capability status...." and incorrectly states that "Shaffer discloses a capability status determination." As explained above in detail, Shaffer does not disclose an email display capability status. In fact, Shaffer never once mentioned the status of anything. Shaffer, therefore, can disclose neither a "capability status determination" as quoted above nor an email display capability status request as claimed in the present application. Receiving in the transcoding gateway from a sender an email display capability status request for the domain as claimed in the present application, therefore, is not rendered obvious by Shaffer's email server that receives an email message. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

The Final Office Action at pages 2 and 3 also asserts that the second element of claim 1 is rendered obvious by Shaffer's email server that receives an email message stating:

> Additionally, the motivation to request client capability is also found within Shaffer which teaches the need for files to be accessible to the client device as well as a conversion consideration, wherein both conversion time and data loss are important access file/sharing issues, (Col. 1, lines 55-67 & Col. 2, lines 1-27)...

That is, the Final Office Action argues that receiving in the transcoding gateway from a sender an email display capability status request for the domain as claimed in the present application is rendered obvious by Shaffer's email server that receives an email message in light of Shaffer at

column 1, lines 55-67, and column 2, lines 1-27. Applicants respectfully note in response, however, that what Shaffer at column 1, lines 55-67, and column 2, lines 1-27, in fact discloses is:

> Even if the attached file is properly decoded at the receiving client device, the file will not be accessible unless the client device has the required application program for opening the attached file. Typically, an attachment has a file format that is specific to an application. For example, an email attachment of a word processing text file may be specific to a particular word processing program. Access to the text is possible only if the receiving client device includes the program or has the capability of converting the decoded file to another file format that is accessible. Video, audio and graphics files typically have more exacting demands. For example, an AVI video formatted file is not converted to a MPEG video formatted file without significantly more complexity than the process of converting from one application-specific word processing file format to a second application-specific word processing file format.
>
> Many client devices have the capability of converting attachments from a limited number of inaccessible file formats to an acceptable me format. If the attachment is a relatively short word processing document, this capability is all that is required for efficient display of the document at the receiving client device. However, if the attached file is large, such as an intra-corporation multimedia presentation of a new product release, the required time to convert the attachment between file formats may lead to a significant inefficient use of the time of corporate personnel. Particularly in the conversion of multimedia file attachments, a complex algorithm must be utilized.
>
> Thus, if a file attachment is received that requires an application that is "foreign" to the receiving computing device, the first issue is whether the computing device is capable of converting the attachment to an accessible file format. A second issue relates to the time requirements of the conversion process, if a conversion is executable. A third issue relates to the reliability of the conversion operation. Often, the conversion causes data loss.
>
> What is needed is a messaging method and system that provide an efficient and reliable exchange of attached files in a multi-application environment.

That is, Shaffer at column 1, lines 55-67, and column 2, lines 1-27, discloses that attachments are not accessible to a client device unless the client device has the required application program for opening the attached file and that client devices often have the capability of converting attachments from only a limited number of inaccessible file formats to an acceptable me format. Shaffer at column 1, lines 55-67, and column 2, lines 1-27, however, does not mention anything

related to an email display capability status or an email display capability status request as claimed in the present application. Shaffer's email server that receives an email message in light of Shaffer at column 1, lines 55-67, and column 2, lines 1-27, therefore, does not teach or suggest receiving in the transcoding gateway from a sender an email display capability status request for the domain as claimed in the present application as claimed in the present application. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Shaffer Neither Teaches Nor Suggests Finding, In Dependence Upon The Domain Identification, At Least One Email Display Capability Status Record For The Domain, Wherein The Email Display Capability Status Record For The Domain Comprises At Least One Of The Email Display Capability Status Attributes

The third element of claim 1 claims 'finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes....' Regarding the third element of claim 1, the Final Office Action at pages 3 and 4 states:

> finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes, (Col. 6, lines 6-67 & Col. 7, lines 1-38);

That is, the Final Office Action takes the position that Shaffer at column 6, lines 6-67 and column 7, lines 1-38 discloses the third element of claim 1. Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67, and column 7, lines 1-38, discloses in summary is receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment, converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible. The Final Office Action attempts to equate Shaffer's determining whether a client device is capable of accessing the attachment with finding, in dependence upon the domain identification, at least one email display capability status record for

the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes as claimed in the present application. Finding an email display capability status record for a domain as claimed in the present application is concerned with identifying email display capability status for an entire destination domain. In contrast, Shaffer is clearly oriented to a single target/client device and not to the display capability status of a domain as claimed in the present application. Moreover, Shaffer's determination of whether a client device is capable of accessing an attachment discloses nothing whatsoever regarding email display capability status as claimed in the present application. Nothing in Shaffer ever detects or advises a sender of the status of the email display capability of a device such as, for example, whether the email display capability of the device is powered on or when a capability was recently used, or any other actual status information. Shaffer at column 6, lines 6-67, and column 7, lines 1-38, therefore, cannot teach or suggest finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes as claimed in the present application. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Shaffer Neither Teaches Nor Suggests Sending
At Least One Of The Email Display Capability Status
Attributes To The Sender Element Of The Independent Claims

The fourth element of claim 1 claims "sending at least one of the email display capability status attributes to the sender." Regarding the fourth element of claim 1, the Final Office Action at page 4 states:

> sending at least one of the email display capability status attributes to the sender, (Col. 6, lines 6-67 & Col. 7, lines 1-38)....

That is, the Final Office Action takes the position that Shaffer at column 6, lines 6-67, and column 7, lines 1-38, discloses the fourth element of claim 1. Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67, and column 7, lines 1-38, discloses

in summary is receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment, converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible. The Final Office Action attempts to equate Shaffer's notification of the sender if conversion is not possible with sending at least one of the email display capability status attributes to the sender as claimed in the present application. Sending email display capability status attributes for a domain to a sender as claimed in the present application is a process that informs a sender of the email display capability status for an entire destination domain during preparation of an email message, so that the sender can select a target device that is actually presently available and on-line, for example, and avoid the entire process of trial and error disclosed in Shaffer. Furthermore, Shaffer's notification of the sender when conversion is not possible is clearly oriented to a single target/client device and not to the display capability status of an entire domain as claimed here. In addition, Shaffer's notification of the sender when conversion is not possible discloses nothing whatsoever regarding email display capability status as claimed in the present application. Nothing in Shaffer ever detects or advises a sender of the status of the email display capability of a device such as, for example, whether the email display capability of the device is powered on or when a capability was recently used, or any other actual status information. Shaffer at column 6, lines 6-67, and column 7, lines 1-38, does not, therefore, teach or suggest sending at least one of the email display capability status attributes to the sender as claimed in the present application. Because the proposed modification of Shaffer does not teach or suggest each and every element and limitation of Applicants' claims, the proposed modification of Shaffer does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Relations Among Claims

Independent claim 1 claims method aspects of email administration according to embodiments of the present invention. Independent claims 8 and 15 respectively claim system and computer program product aspects of email administration according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 8 and 15 are allowable

because claim 1 is allowable. The rejections of claims 8 and 15 therefore should be withdrawn, and claims 8 and 15 should be allowed.

Claims 4-7, 11-14, and 18-21 depend respectively from independent claims 1, 8, and 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the proposed modification of Shaffer does not teach or suggest each and every element of the independent claims, so also the proposed modification of Shaffer cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 4-7, 11-14, and 18-21 therefore should be withdrawn, and these claims also should be allowed.

## ARGUMENT REGARDING THE SECOND GROUND OF REJECTION: CLAIMS 2, 3, 9, 10, 16, AND 17 ARE UNPATENTABLE UNDER 35 U.S.C § 103(A) OVER SHAFFER IN VIEW OF SCHWALM

Claims 2, 3, 9, 10, 16, and 17 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114) in view of Schwalm, *et al,* (U.S. Patent No. 5,339,361). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Shaffer and Schwalm must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Shaffer and Schwalm. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Shaffer and Schwalm. *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the proposed combination of Shaffer and Schwalm does not establish a prima facie case of obviousness. The rejection of claims 2, 3, 9, 10, 16, and 17 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 2, 3, 9, 10, 16, and 17.

The Proposed Combination Of Shaffer and Schwalm Does Not Teach Or Suggest All Of The Claim Limitation Of Applicants Claims

To establish a prima facie case of obviousness, the proposed combination of Shaffer and Schwalm must teach or suggest all of the claim limitations of dependent claims 2, 3, 9, 10, 16, and 17. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Final Office Action relies on the previous 35 U.S.C. § 103 rejection above to reject claims 2, 3, 9, 10, 16, and 17. As Applicants have demonstrated above, the proposed modification of Shaffer does not teach or suggest each and every element of independent claims 1, 8, and 15. Dependent claims 2, 3, 9, 10, 16, and 17 depend from independent claims 1, 8, and 15 and include all of the limitations of the claims from which they depend. Because the proposed combination of Shaffer and Schwalm relies on the argument that the proposed modification of Schaffer discloses each and every element of claims 1, 8, and 15, and because the proposed modification of Shaffer in fact does not teach or suggest each and every element of claims 1, 8, and 15, the proposed combination of Shaffer and Schwalm cannot teach or suggest all the claim limitations of claims 2, 3, 9, 10, 16, and 17. The proposed combination of Shaffer and Schwalm, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

No Suggestion or Motivation to Combine Shaffer and Schwalm

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Shaffer and Schwalm. *In re Vaeck*, 947 F.2d at 493, 20 USPQ2d at 1442. The suggestion or motivation to combine Shaffer and Schwalm must come from the teaching of the references themselves, and the Examiner must explicitly point to the teaching within Shaffer or Schwalm suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Final Office Action makes no clear mention whatsoever of any place in either of the references or elsewhere that suggests or provides any motivation for the proposed combination of Shaffer or Schwalm. The closest the Final Office Action comes to discussing motivation to combine is two cryptic references to obviousness in paragraph 9 on page 7 stating:

> [I]t would have been obvious to incorporate a sender verification means into the Shaffer system for purposes of providing controlled access and transmission/receipt confirmation by authorized parties, (Schwalm – Col. 1, lines 14-52), within an email system which already requires user verification like that of Schaffer, and wherein it would have been obvious to augment the Shaffer controlled access means by implementing sender verification as well.

Applicants take the position that the Final Office Action is asserting that Schwalm at column 1, lines 14-52, provide the motivation or suggestion to combine Shaffer and Schwalm. Applicant respectfully note in response, however, that what Schwalm at column 1, lines 14-52, in fact discloses is:

> Users of electronic information transfer are frequently unable to control access to their transmission systems, to verify the data they send is received, when it was received, and whether it was received by an authorized person. Likewise, a recipient of electronic information is frequently unable to verify that the data they receive was sent by an authorized person or control access to the data sent to them. An electronic data interchange is one example of electronic information transfer and includes, but is not limited to facsimile transmissions, money transfers, modem transfers, security exchanges, electronic mail (E-mail), and government "secured" systems.
>
> Systems heretofore known have allowed for transmission and receipt of electronic information, but provide no means of verifying time of receipt or the identity of the person sending or receiving the electronic information or controlling access to the systems. For example, with current facsimile technology the sender receives verification that a number of pages were transmitted to a given telephone number. The sender does not know who is physically receiving the facsimile at the other end. Likewise, the recipient of a facsimile does not know who the sender is, other than a sending telephone number and perhaps a "name" associated with the sending facsimile machine. Additionally, organizations utilizing facsimile systems for communication would like to control and limit access to their systems. The current extensive use of facsimile transmissions during contract negotiations or for sales orders, sometimes involving millions of dollars, gives rise for a need for a better system for controlling access to facsimile machines, for verifying who sent the facsimile, who received the facsimile, and providing a

> time-stamp for transmission and receipt of the facsimile.
>
> Therefore, a longfelt need has arisen for a system and method which provides controlled access and confirmation of transmission and receipt of electronic information by authorized parties.

That is, Schwalm at column 1, lines 14-52, discloses that users of electronic information transfer are frequently unable to control access to their transmission systems, to verify the data they send is received, when it was received, and whether it was received by an authorized person. Schwalm generally discloses authenticating transmission and receipt of electronic information. *See* Schwalm at Title. Shaffer generally discloses determining the location for performing file-format conversions of email attachments. *See* Shaffer at Title. Schwalm's disclosure at column 1, lines 14-52, that users of electronic information transfer are frequently unable to control access to their transmission systems neither motivates nor suggests combining Schwalm's authenticating transmission and receipt of electronic information with Shaffer's determining the location for performing file-format conversions of email attachments. In fact, Schwalm at column 1, lines 14-52, has nothing whatsoever to do with combining Schwalm's authenticating transmission and receipt of electronic information with Shaffer's determining the location for performing file-format conversions of email attachments. Schwalm at column 1, lines 14-52, merely sets forth the background for the invention of Schwalm. Because the Office Action does not point to an explicit teaching in either Shaffer or Schwalm that suggests or motivates the combination of Shaffer and Schwalm, the Office Action does not establish a prima facie case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

## CONCLUSION OF APPLICANTS' ARGUMENTS

Claims 1, 4-8, 11-15, and 18-21 stand rejected under 35 U.S.C § 103(a) as unpatentable over Shaffer and claims 2, 3, 9, 10, 16, and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over Shaffer in view of Schwalm. For the reasons explained above, the Final Office Action does not establish a prima facie case of obviousness against Applicant's claims over Schaffer alone or in combination with Schwalm within the meaning of 35 U.S.C § 103(a). Claims 1-21 are therefore patentable and should be allowed. Applicants respectfully traverse individually each rejection to claims 1-21 and request reconsideration of claims 1-21.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: July 25, 2006 By: _____

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**APPENDIX OF CLAIMS**
**ON APPEAL IN PATENT APPLICATION OF**
**WILLIAM K. BODIN, *ET AL.*, SERIAL NO. 10/047,018**

CLAIMS

What is claimed is:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

sending at least one of the email display capability status attributes to the sender.

2. The method of claim 1 wherein the email display capability status request includes a sender identification identifying the sender, and the method further comprises

determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

3. The method of claim 2 wherein determining that the sender is authorized to send email to a connection address in the domain further comprises finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain.

4. The method of claim 1 further comprising the steps of:

receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

5. The method of claim 4 wherein:

transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name; and

downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

6. The method of claim 4 wherein determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address.

7. The method of claim 4 wherein forwarding the email further comprises forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

8. A system of email administration comprising:

means for receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

means for receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

means for finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

means for sending at least one of the email display capability status attributes to the sender.

9. The system of claim 8 wherein the email display capability status request includes a sender identification identifying the sender, and the system further comprises means for determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

10. The system of claim 9 wherein means for determining that the sender is authorized to send email to a connection address in the domain further comprises means for finding, in

dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

means for finding at least one email display capability record for the domain further comprises means for finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain.

11. The system of claim 8 further comprising:

means for receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

means for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

means for forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, means for carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

12. The system of claim 11 wherein:

means for transcoding the digital object further comprises means for transcoding the digital object into a digital file having a digital format and a file name; and

means for downloading the transcoded digital object further comprises means for downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

13. The system of claim 11 wherein means for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises means for finding a capability record having a connection address equal to the email address.

14. The system of claim 11 wherein means for forwarding the email further comprises means for forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

15. A computer program product of email administration comprising:

a recording medium;

means, recorded on the recording medium, for receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

means, recorded on the recording medium, for receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

means, recorded on the recording medium, for sending at least one of the email display capability status attributes to the sender.

16. The computer program product of claim 15 wherein the email display capability status request includes a sender identification identifying the sender, and the computer program product further comprises means, recorded on the recording medium, for determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

17. The computer program product of claim 16 wherein means, recorded on the recording medium, for determining that the sender is authorized to send email to a connection address in the domain further comprises means, recorded on the recording medium, for finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

means, recorded on the recording medium, for finding at least one email display capability record for the domain further comprises means, recorded on the recording medium, for finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain.

18. The computer program product of claim 15 further comprising:

means, recorded on the recording medium, for receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

means, recorded on the recording medium, for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

means, recorded on the recording medium, for forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, means, recorded on the recording medium, for carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

19. The computer program product of claim 18 wherein:

means, recorded on the recording medium, for transcoding the digital object further comprises means, recorded on the recording medium, for transcoding the digital object into a digital file having a digital format and a file name; and

means, recorded on the recording medium, for downloading the transcoded digital object further comprises means, recorded on the recording medium, for downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

20. The computer program product of claim 18 wherein means, recorded on the recording medium, for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises means, recorded on the recording medium, for finding a capability record having a connection address equal to the email address.

21. The computer program product of claim 18 wherein means, recorded on the recording medium, for forwarding the email further comprises means, recorded on the recording medium, for forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

## APPENDIX OF EVIDENCE
## ON APPEAL IN PATENT APPLICATION OF
## WILLIAM K. BODIN, *ET AL.*, SERIAL NO. 10/047,018

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the appellants.

## RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).

There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).